

Remarks

I. Status of claims

Claims 1-10 and 22-52 were pending.

Claim 41 has been canceled without prejudice.

Claims 1-10, 24-30, 33-37, 40, 42, 43, and 52 have been allowed.

II. Claim rejections under 35 U.S.C. § 112

Claims 38 and 39 have been amended in a manner that addresses the Examiner's concerns under 35 U.S.C. § 112, second paragraph.

Claims 38 and 39 now are in condition for allowance.

III. Rejection of claims under 35 U.S.C. § 102

A. Claims 22 and 31

The Examiner has rejected claims 22 and 31 under 35 U.S.C. § 102(e) over Silverbrook (U.S. 6,597,817).

Independent claim 22 recites:

22. A process for a camera having a display, comprising:
sensing motion corresponding to motion of the display;
interpreting the sensed motion as a user interface input;
and
presenting on the display images superimposed on a
scene viewed through the camera in accordance with the
interpreted user interface input.

The Examiner has stated that Silverbrook discloses each of the features of claim 22 in FIG. 1 and in col. 2, line 66 through col. 3, line 30. Contrary to the Examiner's statement, however, Silverbrook does not teach any of the process steps recited in claim 22.

Silverbrook's instant camera does not have a display. In FIG. 1, reference number 1 corresponds to a first portrait photograph and reference number 2 corresponds to an area of the first portrait photograph on which textual information relevant to the portrait photograph is printed.

Silverbrook's instant camera does not sense motion corresponding to motion of the display. Instead, Silverbrook's instant camera is configured only to sense the orientation of the instant camera.

Since Silverbrook's instant camera does not sense motion corresponding to motion of the display, it cannot possibly interpret sensed motion as user interface input.

Finally, Silverbrook's instant camera does not present on a display images superimposed on a scene viewed through the camera in accordance with interpreted user interface input. Since Silverbrook's instant camera does not have a display and does not sense motion, it cannot possibly present on a display images superimposed on a scene viewed through the camera in accordance with interpreted user interface input. In addition, since the relevant textual information (i.e., date and location information) already is known by the user (indeed, this information is entered by the user (see col. 3, lines 9-11)), there would be no need whatsoever to present this textual information superimposed on a scene viewed through Silverbrook's instant camera.

For at least these reasons, the Examiner's rejection of independent claim 22 under 35 U.S.C. § 102(e) over Silverbrook should be withdrawn.

Independent claim 31 recites features that essentially track the pertinent features of independent claim 22 discussed above. Therefore, claim 31 is patentable over Silverbrook for at least the same reasons explained above.

B. Claims 41 and 44-49

The Examiner has rejected claims 41 and 44-49 under 35 U.S.C. § 102(e) over Ejima (U.S. 2002/0109782).

1. Claim 41

Claim 41 has been canceled without prejudice.

2. Claim 44

Independent claim 44 recites:

44. A process for a camera having a display, comprising:
sensing motion corresponding to motion of the display;
interpreting the sensed motion as a user interface input;
and
presenting images on the display in accordance with the
interpreted user interface input, wherein presenting comprises
presenting different portions of a virtual panorama in the
display in accordance with the interpreted user interface input,
wherein the virtual panorama is composed of multiple images
captured by the camera.

The Examiner has stated that Ejima's electronic camera presents "different portions of a virtual panorama in the display in accordance with the interpreted user interface input, wherein the virtual panorama is composed of multiple images captured by the camera." In reaching this conclusion, the Examiner has taken the following position:

The Examiner views the virtual panorama as the entire image including regions not currently displayed on the display (6).
The Examiner views an image of "the images captured by the camera" as being the image currently being displayed in the display (6).

Contrary to the Examiner's statement, however, Ejima's electronic camera does not present "different portions of a virtual panorama in the display in accordance with the interpreted user interface input, wherein the virtual panorama is composed of multiple images captured by the camera." Although the Examiner is entitled to interpret claim language in its broadest possible scope, such a scope cannot be contrary to the ordinary meaning of that language as would have been understood by one of ordinary skill in the art at the time the invention was made. The Examiner's assertion that a single captured image that is displayed on the LCD of Ejima's electronic camera constitutes a virtual panorama composed of multiple images captured by the camera is contrary to the ordinary and accustomed meaning that one of ordinary skill in the art at the time of the invention would have given to the language "wherein the virtual panorama is composed of multiple images captured by the camera." One of ordinary skill in the art at the time the invention was made simply would

not have reasonably considered a single image captured by a camera to be a virtual panorama composed of multiple images captured by the camera.

For at least these reasons, the Examiner's rejection of independent claim 44 under 35 U.S.C. § 102(e) over Ejima should be withdrawn.

3. Claims 45-47

Independent claim 45 has been amended and now recites:

45. A process for a camera having a display, comprising:
sensing motion corresponding to motion of the display;
interpreting the sensed motion as a user interface input;
presenting images on the display in accordance with the
interpreted user interface input, including superimposing a
pointer on an external scene viewed through the display; and
selecting boundaries of a portion of the external scene
based on the interpreted user interface input and locations of
the pointer superimposed on views of the external scene.

In his rejection of claim 45, the Examiner appears to have copied his statement of reasons for rejecting claim 44. These reasons, however, do not relate to the pertinent features of independent claim 45. Nevertheless, Ejima does not teach or suggest the inventive process now recited in claim 45. In particular, Ejima's electronic camera does not superimpose a pointer on an external scene viewed through the LCD display. Ejima's electronic camera also does not select boundaries of a portion of the external scene based on the interpreted user interface input and locations of the pointer superimposed on views of the external scene.

Each of claims 46 and 47 incorporates the features of independent claim 45 and therefore is patentable over Ejima for at least the same reasons.

4. Claims 48 and 49

Claim 48 recites "modifying a captured image in response to the interpreted user interface input."

Claim 49 recites "modifying a captured image in response to the interpreted user interface input, wherein modifying comprises cropping the captured image."

In support of his rejection of claims 48 and 49, the Examiner has stated that:

Ejima et al. teaches on Paragraph [0191] and depicts in Figure 19 selecting the scene portion (zoomed region). This process of changing the displayed image to an image corresponding to the selected region is viewed by the examiner as modifying a captured image (displayed image) in response to the interpreted user interface input (zoom command).

Contrary to the Examiner's statement, however, Ejima's electronic camera does not modify "a *captured image* in response to the interpreted user interface input," as recited in claim 48. Ejima's electronic camera also does not modify "a *captured image* in response to the interpreted user interface input, wherein modifying comprises cropping the *captured image*," as recited in claim 49. When Ejima's electronic camera interprets sensed motion parallel to the optical axis, the camera merely increases or decreases the size of the displayed image, presumably by changing the rate at which the corresponding captured image is sampled. This process does not modify the captured image in any way whatsoever. Moreover, this process does not involve modifying any image. Instead, this process simply involves sampling the captured image (or portions of the captured image) at different sampling rates to produce different images that are displayed on the LCD.

In addition, although the Examiner is entitled to interpret claim language in its broadest possible scope, such a scope cannot be contrary to the ordinary meaning of that language as would have been understood by one of ordinary skill in the art at the time the invention was made. The Examiner's assertion that a displayed image that is derived from sampling a captured image constitutes a captured image is contrary to the ordinary and accustomed meaning that one of ordinary skill in the art at the time of the invention would have given to the term "captured image". One of ordinary skill in the art at the time the invention was made simply would not have reasonably considered a sampled version of a captured image that is displayed on the LCD of Ejima's camera to be a captured image. Instead, such an image is merely a separate and distinct images that is derived from the captured image.

For at least these reasons, the Examiner's rejection of independent claims 48 and 49 under 35 U.S.C. § 102(e) over Ejima should be withdrawn.

IV. Rejection of claims under 35 U.S.C. § 103

A. Claims 22 and 31

The Examiner has rejected claims 23 and 32 under 35 U.S.C. § 103(a) over Silverbrook in view of Ejima.

Claims 23 and 32 incorporate the features of independent claims 22 and 31, respectively. Ejima does not make-up for the failure of Silverbrook to teach or suggest anything about presenting on a display of a camera images superimposed on a scene viewed through the camera. Therefore, claims 23 and 32 are patentable over Silverbrook and Ejima for at least these reasons.

B. Claims 50 and 51

The Examiner has rejected claims 50 and 51 under 35 U.S.C. § 103(a) over Ejima.

1. Claim 50

Claim 50 recites “modifying a captured image in response to the interpreted user interface input, wherein modifying comprises changing color parameters associated with the captured image.”

As explained above in connection with claims 48 and 49, Ejima’s electronic camera does not modify “a *captured image* in response to the interpreted user interface input.” When Ejima’s electronic camera interprets sensed motion parallel to the optical axis, the camera merely increases or decreases the size of the displayed image, presumably by changing the rate at which the corresponding captured image is sampled. This process does not modify the captured image in any way whatsoever. Moreover, this process does not involve modifying any image. Instead, this process simply involves sampling the captured image (or portions of the captured image) at different sampling rates to produce different images that are displayed on the LCD.

In addition, although the Examiner is entitled to interpret claim language in its broadest possible scope, such a scope cannot be contrary to the ordinary meaning of that

language as would have been understood by one of ordinary skill in the art at the time the invention was made. The Examiner's assertion that a displayed image that is derived from sampling a captured image constitutes a captured image is contrary to the ordinary and accustomed meaning that one of ordinary skill in the art at the time of the invention would have given to the term "captured image". One of ordinary skill in the art at the time the invention was made simply would not have reasonably considered a sampled version of a captured image that is displayed on the LCD of Ejima's camera to be a captured image. Instead, such an image is merely a separate and distinct images that is derived from the captured image.

For at least these reasons, the Examiner's rejection of independent claim 50 under 35 U.S.C. § 103(a) over Ejima should be withdrawn. The Examiner's rejection of claim 50 under 35 U.S.C. § 103(a) over Ejima also should be withdrawn for the following additional reasons.

Ejima's electronic camera also does not modify "a captured image in response to the interpreted user interface input, wherein modifying comprises changing color parameters associated with the captured image." Indeed, Ejima does not teach or suggest anything whatsoever about changing color parameters associated with a captured image. In an attempt to make-up for this failure, the Examiner has provided the following reasons in support of his rejection of independent claim 50:

Official notice is taken that it was well known in the art at the time the invention was made to enable a user to change the color parameters of a captured image in order to improve the image quality.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the camera of Ejima et al. with a color processing command that allows a user to correct the color intensities of an image and therefore improve image quality.

With this rejection, however, the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a). In particular, the Examiner has not provided the requisite factual basis and failed to establish the requisite motivation to support his deemed conclusion that the features recited in claim 50 would have been obvious to one of ordinary skill in the art at the time of the invention. The Examiner's statement that "it was well known ... to enable a user to change the color parameters of a captured image in order to

improve the image quality” does not meet the Examiner’s obligation to point to some teaching or suggestion in the cited references or in the knowledge generally available that would have led one of ordinary skill in the art to the invention recited in claim 50.¹ In this regard, the Examiner is obligated to explain why one skilled in the art at the time the invention was made would have been motivated to modify Ejima’s electronic camera to change color parameters associated with a captured image when Ejima does not teach or suggest anything about modifying a captured image in any way whatsoever.

In addition, MPEP § 2144.03B explains the obligations of the Examiner when taking official notice of a fact that is asserted to be common knowledge without specific reliance on documentary evidence (citations omitted):

If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

If the Examiner persists with these rejections, he is obligated to provide specific factual findings regarding how color parameters are changed in the generally available knowledge on which the Examiner has relied and how the generally available knowledge would have led one skilled in the art to make specific modifications to Ejima’s electronic camera. If the Examiner cannot comply with the requirements of MPEP § 2133.03B, he is requested to cite other art in support of his assertions. Alternatively, if the Examiner is aware of facts within his personal knowledge that provide the requisite factual basis and establishes the requisite motivation to support his deemed conclusion that the features recited in claim 50 would have been obvious, the Examiner is requested to provide an affidavit in accordance with 37 CFR § 1.104(d)(2). Otherwise, the Examiner’s rejection of claim 50 should be withdrawn for at least this additional reason.

¹ See MPEP § 2143.01 (citations omitted): “A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.”

Applicant : D. Amnon Silverstein
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The Examiner's rejection of independent claim 50 under 35 U.S.C. § 103(a) over Ejima should be withdrawn for at least these additional reasons.

2. Claim 51

Claim 51 incorporates the features of independent claim 22. Ejima does not teach or suggest anything about presenting on a display of a camera images superimposed on a scene viewed through the camera. Therefore, claim 51 is patentable over Ejima for at least these reasons.

V. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

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Edouard Garcia
Reg. No. 38,461
Telephone No.: (650) 289-0904

Please direct all correspondence to:

Hewlett-Packard Company
Intellectual Property Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80528-9599